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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,443	08/27/2003	Anton Bakker	001672-23	4600
<div>22204      7590      09/19/2007</div> <div>NIXON PEABODY, LLP</div> <div>401 9TH STREET, NW</div> <div>SUITE 900</div> <div>WASHINGTON, DC 20004-2128</div>				
			EXAMINER	
			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/648,443

**Applicant(s)**

BAKKER ET AL.

**Examiner**

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/16/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 7, 9, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 2, 9, it is not clear what structure is being claimed that is capable of determining the different rewards.
- Claim 7, 14, it is unclear how the system's structure is being further defined by the language that describes the types of businesses that happen to employ the system. Regardless of who uses the system, it is still the same system.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**4. Claims 1, 2, 4-9, 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by McCarthy (US5287268).**

Regarding claims 1, 6, 8, 13, 15, McCarthy teaches a generic loyalty system that operates with a single identification card (identification device), but at a plurality of merchants [abstract]. The card's magnetic stripe is read at the point of sale (POS) during a purchase transaction and the user's account is identified; the merchant's award formulary (credit rate) is applied and the appropriate credits are associated with the user's account by the host [col 1: lines 59-68]. The merchant identifier is also passed to the host in order to enable the system to identify the associated merchant's account [4:45-52]. Each merchant may define a different award rate [3:29-45].

Regarding claims 2, 9, items purchased from merchant 1 can be taken to be in a category different from items purchased at merchant 2 (having a different reward rate).

Regarding claims 4, 11, the system of McCarthy is taken to inherently include an interface which was used to create/update user accounts, merchant accounts, merchant reward rates, etc.

Regarding claims 5, 12, the users of McCarthy may accumulate credits earned via their purchases [3:64-66].

Regarding claims 7, 14, McCarthy does not appear to mention the *types* of merchants of the plurality of merchants comprising his system. However, the types of merchant and/or the types of products sold by the merchant does not appear to change in any way the structure of the claimed system itself. Further, the claim language is so broad and encompasses such a wide net of merchant types that, coupled with

McCarthy's idea of a plurality of merchant locations 14 that the disclosure is taken to inherently provide at least one of the merchant types mentioned in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 7, 14 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy.**

Regarding claims 7, 14, it would have been obvious to one of ordinary skill at the time of the invention for merchants who have a retail store to become a part of McCarthy's system so that they can offer loyalty incentives to their customers as is generally accepted among grocery stores. McCarthy's system does not appear to have any limitations regarding the types of products or services that can be sold in order to earn loyalty rewards.

7. **Claims 3, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Chasko (US6901373).**

Regarding claims 3, 10, McCarthy does not offer variable award rates within a single merchant's premises. Chasko however teaches a loyalty system where a merchant can offer varying loyalty rewards depending on the item's (profit margin)

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category. In this manner certain products categories can yield different rewards within a single merchant. It would have been obvious to one of ordinary skill at the time of the invention to have defined a variable reward profile (rather than a single rate) for a collection of different item (profit margin) categories. This enables the merchant to provide incentives for certain desirable products categories.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dorf teaches a single card with multiple functions including a loyalty system that can reward users for purchases of particular items [9:38-67].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc